

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

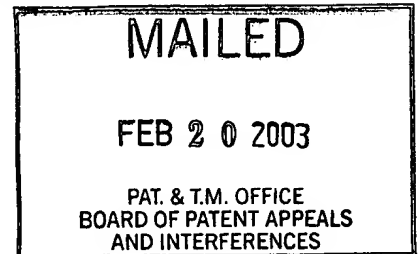
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGG WAGNER and ROBERT STEWART

Appeal No. 2002-1573
Application No. 09/113,446

ON BRIEF



Before COHEN, FRANKFORT, and STAAB, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 6 through 11. Claims 1 through 5 stand withdrawn. These claims constitute all of the claims remaining in the application.

Appellants' invention pertains to a housing for a portable handheld electronic reader/scanner. A basic understanding of the invention can be derived from a reading of exemplary claim 6, a copy of which appears in the APPENDIX to the main brief (Paper No. 10).

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As evidence of anticipation and obviousness, the examiner has applied the documents listed below:

Matone, Jr. et al (Matone)	4,758,712	Jul. 19, 1988
Mottmiller et al (Mottmiller)	5,368,380	Nov. 29, 1994
Schmidt et al (Schmidt)	5,796,091	Aug. 18, 1998 (filed May 13, 1996)

The following rejections are before us for review.

Claims 6 through 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schmidt.

Claims 9 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schmidt in view of Matone.

Claim 11 stands rejected under 35 U.S.C. § 103 as being unpatentable over Schmidt in view of Mottmiller.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the final rejection and the main and supplemental answers (Paper Nos. 6, 11

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and 15), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 10 and 12).

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims, the applied teachings,¹ and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

We do not sustain the rejection of claims 6 through 8 under 35 U.S.C. § 102(b) as being anticipated by Schmidt.

¹ In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach specifically what an appellant has disclosed and is claiming but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Appellants' claim 6 sets forth a housing for a portable handheld electronic reader/scanner comprising, inter alia, a one-piece hollow body portion made of a thermoplastic elastomer having an electronics enclosure portion and a handle portion,

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with the electronics enclosure portion having an aperture
entirely surrounded by a body perimeter portion.

The recitation of a "one-piece" hollow body portion is clearly understood when read in light of the underlying specification (page 4, lines 10 through 12) which expressly recites the following.

Body portion 12 is made as a single part rather than as two joined halves. This eliminates the need for bonding or otherwise joining two halves and also eliminates the presence of an unattractive seam line.

Based upon the above, the claim recitation of a "one-piece" hollow body portion denotes a hollow body portion fabricated from a single part and not from halves (parts) joined together.

The patent to Schmidt teaches a housing for a portable bar code symbol reading device (a portable handheld electronic reader/scanner). The patentee discloses (column 13, lines 53 through 67) that the hand-supportable housing is a "five-piece split housing," with a first housing portion 9C and a second housing half 9D being provided, as seen in Figs. 3A. The showing in the patent, e.g., Fig. 1E, makes it visually apparent that the

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housing portion that is akin to the claimed one-piece hollow body portion is not one-piece but is configured as housing parts that are joined together. It is for this reason that the anticipation rejection cannot be sustained.

The obviousness rejections

We do not sustain the respective rejections of claims 9 and 10 and claim 11 under 35 U.S.C. § 103.

Simply stated, the teaching of Matone and the disclosure of Mottmiller do not overcome the deficiency of the Schmidt patent, as discussed immediately above.

REMAND TO THE EXAMINER

The examiner should assess the patentability of appellants' claims under 35 U.S.C. § 103 in view of prior art, e.g., Schmidt, and taking into full account the fabrication options available to one having ordinary skill in the art of one-piece and multiple part constructions with their respective known benefits.

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In summary, this panel of the board has not sustained any of the rejections on appeal, and has remanded the application for the reason stated above.

The decision of the examiner is reversed.

REVERSED AND REMANDED



IRWIN CHARLES COHEN)
Administrative Patent Judge)



CHARLES E. FRANKFORT)
Administrative Patent Judge)



LAWRENCE J. STAAB)
Administrative Patent Judge)

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD 7TH FLOOR
LOS ANGELES, CA 90025